

REMARKS

In the Office Action, claims 1, 5-6, 9-11 and 13-20 were rejected, claims 3 and 4 were allowed, and claim 8 was objected to by the Examiner. Applicants thank the Examiner for allowing claims 3 and 4 and for indicating the allowability of claim 8. Claims 5, 13 and 20 have been amended, claims 2 and 7 were previously withdrawn, claims 12 and 15-19 have been canceled without prejudice, and claims 1, 3-6, 8-11, 13-14 and 20 remain pending in the present application. All claim amendments are fully supported throughout the written description and figures of the specification.

Claims 5, 6, 10, 11, 13, 14 and 15-19 were rejected under 35 USC 103(a) as unpatentable over the Longbottom et al. reference, US Patent No.: 6,079,494 in view of the Mashaw Jr. et al. reference, US Patent No.: 5,211,241 or the Schnatzmeyer reference, US Patent No.: 5,957,207. Independent claims 5 and 13 have been amended to clarify certain aspects of the invention. The claims rejected under 35 USC 103(a) are patentably distinct over the cited references.

The Longbottom et al. reference discloses a pair of separate tubing strings 50, 52. The tubing string 52 has a conventional plug 56 and a remotely controllable flow regulating device 58 that acts to regulate the rate of fluid flow through a side wall portion of tubing string 52. (Column 5, lines 10-22 and 65-66). A dual string packer 66 sealingly engages tubing strings 50, 52 which extend downwardly from packer 66 as completely separate tubes. (Column 6, lines 17-18). The Mashaw Jr. et al. reference and the Schnatzmeyer reference each disclose a flow control device that can be used to regulate fluid flow. However, none of the cited references, alone or in combination, discloses or suggests various elements found in independent claims 5, 13 or 14.

For example, the cited references fail to disclose or suggest a conduit having a first bore within a second bore "radially surrounding the first bore" in combination with a sleeve member that may be moved at "predetermined increments" to selectively choke the flow through the second bore, as recited in amended, independent claim 5. The cited references also fail to disclose or suggest a method of controlling fluid flow in which a body defines a first passageway and "a second passageway radially surrounding the first passageway" in combination with

selectively choking and sizing the second passageway with "a total flow area at least as great as the flow area of the first passageway" as recited in amended, independent claim 13. Furthermore, the cited references fail to disclose or suggest a valve with a body defining a longitudinal first bore and second passageway that communicates flow from "a position upstream of the closure member to a position downstream of the closure member to provide a bypass flow" in combination with a valve and a pressurized fluid passageway to bias the valve to full choke, as recited in independent claim 14. The unique structure and methodology recited in these claims is very different from the disclosure of the Longbottom et al. reference which merely utilizes two tubing strings separated from each other in the wellbore, as described above. The specific flow control devices of the other cited references do not suggest any modification of the Longbottom et al. reference sufficient to establish a prima facie case of obviousness. Accordingly, independent claims 5, 13 and 14 are patentable over the cited references.

Claims 6, 10 and 11 ultimately depend from independent claim 5 and are patentable for the reasons provided above with respect to independent claim 5 as well as for the unique subject matter recited in each of these dependent claims. Claims 15-19 have been canceled without prejudice.

Claim 1 was rejected under 35 USC 103(a) as unpatentable over the Longbottom et al. reference in view of the Mashaw Jr. et al. reference or the Schnatzmeyer reference and further in view of the French reference, US Patent No.: 6,286,594. Claim 1 also was rejected under 35 USC 103(a) as unpatentable over the Mashaw Jr. et al. reference and the Mashaw Jr. et al. reference, US Patent No.: 5,183,114, in view of the French reference. However, the French reference is not believed to constitute prior art with respect to this claim. Accordingly, no prima facie case of obviousness has been established.

The present application is a continuation-in-part of US patent application no. 09/441,701 claiming priority to US provisional application no. 60/108,810, which was filed on November 17, 1998 and fully supports the subject matter of pending claim 1. The French reference was not published until April 22, 1999. Although the French reference lists foreign application priority data as a GB application filed October 9, 1997, patents resulting from an international

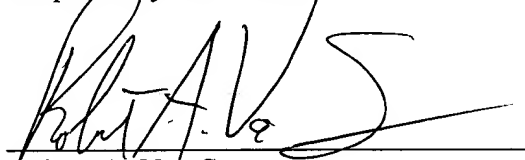
application filed before November 29, 2000 shall not be effective as prior art as of the filing date of the international application. Accordingly, the French reference should not be relied on by the Examiner and independent claim 1 should be allowed.

Claims 13, 14 and 20 were rejected under 35 USC 103(a) as unpatentable over the Longbottom et al. reference in view of the French reference. Independent claim 13 has been amended as discussed above and is patentably distinguishable over the Longbottom et al. reference for the reasons provided above. The French reference does not provide any additional teaching to obviate the deficiency of disclosure in the Longbottom et al. reference. Independent claims 14 and 20 also are patentably distinguishable over the cited references. However, support for the subject matter of these claims is believed to predate the French reference as discussed above with respect to claim 1. Accordingly, the French reference is not available as prior art and no prima facie case of obviousness has been established with respect to these claims.

Claim 9 was rejected under 35 USC 103(a) as unpatentable over the Longbottom et al. reference in view of the Mashaw Jr. et al. reference or the Schnatzmeyer reference and further in view of the Bouldin et al. reference, US Patent No.: 5,979,558, or the Schnatzmeyer reference. Claim 9 directly depends from amended, independent claim 5 and is patentable over the cited references for the reasons provided above with respect to independent claim 5 as well as for the unique subject matter recited in claim 9. The Bouldin et al. reference does not obviate the deficiencies of disclosure in the previously cited references.

In view of the foregoing remarks, the pending claims are believed patentable over the cited references. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R.A. Van Someren', written over a horizontal line.

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